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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,666	08/31/2001	Eleanor G. Rieffel	110012	7817

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EXAMINER

BRIER, JEFFERY A

ART UNIT	PAPER NUMBER
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2628

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/942,666	RIEFFEL ET AL.	
	Examiner	Art Unit	
	Jeffery A. Brier	2628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-25,27-48,50-66,68 and 70-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-25,27-48,50-66,68 and 70-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on 3/13/2006 has been entered. The amendment to claims 68 and 70 overcomes the objection to those claims.

2. The amendment filed 3/13/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: in paragraph 0037 applicant added “, such as a shape of the digital ink”. The originally filed sentence in paragraph 0037 stated: It will also be apparent that the digital ink controlling circuit 232 may be used to change any display characteristics of the digital ink such as color, thickness, fade or duration time or any other known or later developed display characteristics of the digital ink. This sentence as well as the application as a whole does not convey that which applicant has added to paragraph 0037. Originally filed claim 21 claimed “wherein the display attributes include at least one of a color, thickness and shape of the selected digital inks.”. However, this does not state the “later developed display characteristics of the digital ink, such as a shape of the digital ink” since the claim did not discuss any “later developed display characteristics of the digital ink”. Applicant is required to cancel the new matter in the reply to this Office Action.

3. Claim 7 depends upon cancelled claim 6. Claims 27 and 28 depend upon cancelled claim 26. Claim 50 depends upon cancelled claim 49.

Response to Arguments

4. The amendments made to claims 70-72 overcomes the 102 rejection based on the NetDraw article.

5. Applicant's arguments filed 3/13/2006 have been fully considered but they are not persuasive regarding claims 1, 24, and 44. The amendments made to these claims do not make the list alternative because the phrase "at least one selected from the group consisting of" does include all of the element in the list and even includes several of the same element. As set forth previously the specification describes the claimed elements to be used alternatively and describes using only one of the elements rather than several of the same element. Thus, the amendment to these claims raises different 35 USC 112 issues.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-5, 7-25, 27-48, 50-66, and 70-73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 24, and 44:

These claims claim “the predetermined time being based on at least one selected from the group consisting of: appearance..., appearance..., application of a first stroke..., completion ..., and an intonational phrase” (hereinafter A, B, C, D, and E) which do not make the list alternative because the phrase “at least one selected from the group consisting of” does include all of the element in the list and even includes several of the same element. As set forth previously the specification describes the claimed elements to be used alternatively and describes using only one of the elements rather than several of the same element as described in paragraphs 0037-0041. These paragraphs clearly describe the fading to be based upon alternative variables. Note lines 5-9 of paragraph 0037 which clearly uses the alternative “or” to connect the two variables which are the first two claimed appearance variables. Note lines 12-14 of paragraph 0037 which clearly uses the alternative “or” to connect the three variables which are the last three claimed variables (a first stroke..., completion ..., and an intonational phrase). Note line 12 of paragraph 0037 which starts with “Furthermore, it will be apparent that the fading may start...” which alternatively connects this sentence to the previous sentence describing fading variables in the alternative. This claim claims A, B, C, D, and E and claims more than one of A or more than one of B or more than one of C or more than one of D or more than one of E. Both of which is not described in paragraphs 0037-0041. The former of which is not described in paragraphs 0037-0041 even in light of originally filed claim 6. The specification even in

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light of originally filed claim 6 does not teach how the five variables may be used together to determine the predetermined time.

Claims 4 and 47:

These claims have the same phrase that claims 1, 24, and 44 have “at least one selected from the group consisting of”. In claims 4 and 47 the second condition is determined based upon five variables. It is based upon one occurrence of the five variables and upon several occurrences of the five variables. The specification does not describe using several occurrences of the five variables. Thus, this claim should be amended to claim “the second condition is based upon one of user specification, ...”. Also the specification seems to be silent about “user identification”. If applicant wishes to continue to claim this then the specification should be amended.

Claims 21, 41, and 64:

In claims 21, 41, and 64 “shape of the selected digital inks” is claimed, however, the specification does not mention this, thus, if applicant wishes to continue to claim this then the specification should be amended to describe this attribute of the digital ink. The amendment to the specification did not correctly add this limitation into the specification.

These claims also claim “at least one of color, thickness and shape of the selected digital inks”, therefore they are indefinite for the same reasons given in the office action mailed on 12/12/2005. In view of Superguide, IPXL Holdings, and Brown this phrase is to be read as at least one of A, B, C, D, and E and is not alternative, thus, this claim does not distinctly claim that which is described in paragraphs 0037-0041.

Claims 7, 27, 28, and 50:

Claim 7 depends upon cancelled claim 6. Claims 27 and 28 depend upon cancelled claim 26. Claim 50 depends upon cancelled claim 49.

Claims 70, 72, and 73:

These claims are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the necessary steps that occur after only the faded or fading digital ink is recovered.

Claim 71:

This claim is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the necessary elements that respond to the recovery system recovering only the selected fading or faded digital ink occur after the faded or fading digital ink is recovered.

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-5, 7-25, 27-48, 50-66, and 70-73 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

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application was filed, had possession of the claimed invention. For the reasons given above with regard to claims 1, 4, 24, 44, and 47 for the phrase “at least one selected from the group consisting of” the originally filed application does not convey that applicant had possession of A, B, C, D, and E and does not convey that applicant had possession of more than one of A or more than one of B or more than one of C or more than one of D or more than one of E. Both of which is not described in paragraphs 0037-0041. The former of which is not described in paragraphs 0037-0041 even in light of originally filed claim 6. The specification even in light of originally filed claim 6 does not teach how the five variables may be used together to determine the predetermined time.

Claims 70-73:

These claims were amended to claim “recovering only the selected faded or fading digital ink”. However, the specification, see paragraph 0050, does not state how digital ink recovery circuit 233 recovers the digital ink, thus, it does not convey applicant had possession of a circuit that “only” recovers the selected digital ink.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 1-5, 7-25, 27-48, 50-66, 68, and 70-73 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-5, 7-25, 27-48, and 50-66:

Independent claims 1, 24, and 44 all claim "digital ink on a media" and were amended to alternatively to claim elements A, B, C, D, and E as well as claiming other combinations of these elements. It is not apparent from this amended claims the "concrete, useful, and tangible result". The term "media" is an abstract entity without a clear definition in the specification. Paragraph 20 defines media as a broad range of images and objects. Paragraph 21 describes outputs devices used to display the "process media data", however, this "concrete, useful, and tangible" output having a "concrete, useful, and tangible result" is not claimed. Thus, these claims are directed to manipulating abstract ideas. *State Street Bank & Trust Co. v. Signature Financial Group Inc.* (CA FC) 47 USPQ2d 1596, 1603 (7/23/1998). *AT&T Corp. v. Excel Communications Inc.* (CA FC) 50 USPQ2d 1447. On page 1603 first paragraph the CAFC wrote in *State Street*:

Under *Benson*, this may have been a sufficient indicium of nonstatutory subject matter. However, after *Diehr* and *Alappat*, the mere fact that a claimed invention involves inputting numbers, calculating numbers, outputting numbers, and storing numbers, in and of itself, would not render it nonstatutory subject matter, unless, of course, its operation does not produce a "useful, concrete and tangible result." *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557. 7

On page 1603 paragraph labeled [4] the CAFC wrote:

[4] The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to -- process, machine, manufacture, or composition of matter-- but rather on the essential characteristics of the subject matter, in particular, its practical utility. Section 101 specifies

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that statutory subject matter must also satisfy the other "conditions and requirements" of Title 35, including novelty, nonobviousness, and adequacy of disclosure and notice. See *In re Warmerdam*, 33 F.3d 1354, 1359, 31 USPQ2d 1754, 1757-58 (Fed. Cir. 1994).

Claim 68:

This claim claims "digital ink on a media" and were amended to claim "selecting at least one digital ink to fade" and "fading at least one of the selected at least one digital ink based on at least one condition". It is not apparent from this amended claim the "concrete, useful, and tangible result". See the above discussion given for claims 1, 24, and 44.

Claims 70-73

Independent claims 70-72 all claim "digital ink on a media" and were amended to claim "recovering only the selected faded or fading digital ink". It is not apparent from these amended claims the "concrete, useful, and tangible result". See the above discussion given for claims 1, 24, and 44.

Allowable Subject Matter

12. A prior art rejection cannot be made of 1-5, 7-25, 27-48, and 50-66 and 70-73 because the metes and bounds of the claims are not definite and because the specification does not support the claims. Thus, an indication of allowability would be premature. In *re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962) (it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a

rejection under 35 U.S.C. 103 on these assumptions). However, as stated in the previous office action for claims 1-5, 7-25, 27-48, and 50-66.

Claims 1-5, 7-25, 27-48, and 50-66:

The prior art of record fails to teach or suggest the five variables alternatively used to determine the predetermined time. See applicant remarks filed on 9/28/2005 at pages 14 and 15.

Claim 68:

The prior art of record fails to teach or suggest wherein the predetermined speed depends on an importance determination of a word in the media marked by the digital ink, however, it does need a displaying step displaying the media, displaying the digital ink on the displayed media, and displaying the fading digital ink displayed on the displayed media which displaying step needs to be in alignment with the specification.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:00 to 3:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (571) 272-7664. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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